

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANTS:	Peri Hartman, et al.
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EXAMINER:	Mark A. Fadok
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REPLY BRIEF

This Brief is in reply to the Examiner's Answer mailed October 11, 2006.

Argument

This Applicants' Response to the Examiner's Answer is necessitated because of errors and inaccuracies in the Examiner's Answer. Moreover, Examiner often fails to carry his burden of proof throughout the Answer. Specifically, the Examiner uses Official Notice excessively, has neglected to remove arguments he acquiesced that Applicants had overcome, and fails to show valid motivations to combine references as described throughout.

By way of example as to the Examiner Answer failing to convey its burden of proof, the Examiner's use of Official Notice seems impermissibly excessive.¹ The Examiner takes Official Notice on *twenty-one* separate occasions in the Examiner's Answer, apparently every time the references on which the Examiner relies do not readily show some claimed feature. Under MPEP 2144.03, this overly liberal use of Official Notice is too excessive in light of the guidance provided therein. Applicants continue to make specific traversals and arguments regarding Official Notice herein,² but if the rejections are to be maintained, the Board should require the Examiner to provide references to show the subject matter that is alleged to be well known for all instances of Official Notice that do not fall under the requirement of MPEP 2144.03. Specifically, that the facts asserted to be well known are "capable of instant and unquestionable demonstration as being well-known." MPEP 2144.03A.

A further example of errors and inaccuracies in the Examiner's Answer is illustrated by several instances in which the Examiner has retained arguments in the Grounds of Rejection for

¹ MPEP 2144.03 states that official notice without documentary evidence is permissible only in some circumstances, and should be rare, for example, when an application is on final rejection. (Emphasis Added)

² In addition, the Examiner indicates that Applicants have not traversed some instances of Official Notice. Applicants submit that the intention of filing and maintaining the Appeal was to finally make progress on the issues, and as a result intended to traverse these points.

which the Examiner has indicated that he acquiesced to Applicants' arguments. Specifically, the Examiner agrees that he impermissibly relies on Applicants' own disclosure as a basis for rejection. The Examiner should have removed these arguments from consideration, as noted herein. Thus, the Examiner's arguments relating to these points should not be considered by the Board.

The Rejections of Claims under Section 35 USC § 103 Should Be Reversed

Claims 108-117, 151-156, and 176-183 have been rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,819,034 ("Joseph") in view of 5,815,665 ("Teper") and further in view of Official Notice. This rejection is respectfully traversed.

Claims 108, 151, 176 (and their respective dependencies)

Claim 108 is representative of claims 108, 151, and 176 for the purposes of the discussion below, and recites:

A method in a client system for ordering an item, the method comprising:
receiving from a server system a client identifier of the client system;
persistently storing the client identifier at the client system;
when an item is to be ordered,
 displaying information identifying the item and displaying an indication of a
 single action that is to be performed to order the identified item; and
in response to the single action being performed, sending to the server system a
request to order the identified item along with the client identifier, the
client identifier identifying account information previously supplied by a
user of the client system wherein the user does not need to log in to the
server system when ordering the item; and
when account information is to be changed,
 coordinating the log in of the user to the server system;
receiving updated account information; and
sending the updated account information to the server system
whereby the user does not need to log in to the server system when ordering an
item, but does need to log in to the server system when changing
previously supplied account information.

The Examiner argues that Joseph teaches “receiving information from a server system” and “storing information persistently for transmittal to a server system” and that Teper teaches providing a unique identifier. From this, the Examiner concludes that “[i]t would have been obvious... to include in Joseph storing an identifier... as taught by Teper, because it would free up storage space on the client computer....” Examiner’s Answer 10/11/2006, p. 5. Applicants submit that the Examiner is incorrect in several respects.

First, the information that the client of Joseph *receives from the server* is stored temporarily, if at all. Joseph indicates that “no mass storage is required” and “only the currently executing portion of the program need be stored in memory.” Joseph, col. 3, ll. 23-27. Further, “When the currently executing portion has completed, its memory space is freed up.” Joseph, col. 3, ll. 27-29. Thus, this information is not stored “persistently” at the client as required by the claims.

Second, the Examiner’s statement that Joseph teaches “storing information persistently *for transmittal to a server system*” also is incorrect. The connection between the server and client of Joseph is a *one-way* communication path *from the server to the client*. Joseph, col. 3, ll. 1-11. Thus, Joseph can send nothing to the server. Therefore, the Examiner’s self-serving reading of Joseph and subsequent faulty conclusion that “Joseph...persistently stores information that is sent to [sic] the server system,” is incorrect. Office Action 10/7/2005, p. 7.³ The Examiner also points to Teper at col. 3, ll. 1-21. Examiner’s Answer at p. 21. However, this section of Teper is the brief figure descriptions, and Applicants cannot find any mention of persistent storage.

³ Although Applicants previously believed the Examiner was correct that “Joseph...persistently stores information that is sent [from] the server system, because it appeared the Examiner mistyped the claim by using “to” rather than “from”. However, now seeing that Examiner’s error is resulting in further confusion, Applicants are correcting this misstatement“to” to be a typo for “from,” (See Replacement Appeal Brief at p. 23), Applicants now correct that misstatement.

Joseph also discloses permanent storage of *client*-entered information (*see, e.g.*, col. 8, ll. 52-57). However, this information is entered in at the client, not received *from the server* as is claimed.

Next, the Examiner alleges that Teper discloses an identifier as claimed. This is incorrect. The user ID of Teper identifies a *user* of the Teper system. *See, e.g.*, Teper, col. 2, l. 67 – col. 3, l. 4; col. 3, l. 20. In contrast, the present claims recite “a client identifier *of the client system*.” That is, it identifies a client *system* 220, rather than the user or “customer” of the client system.⁴ These are two different entities.

Despite the articulated differences above, even assuming *arguendo* that Joseph and Teper could be combined as the Examiner suggests, the combination would not result in the claimed invention. At best it would provide either receiving from a server a *user* identifier and temporarily storing the *user* identifier at a client system, or storage of a *user* identifier *entered by a user*. This combination of Joseph and Teper does not recite at least “receiving from a server system a client identifier of the client system; [and] persistently storing [it]. Thus, Applicants submit that claims 108, 151, and 176 are patentable over the cited references, considered alone or in the combination suggested by the Examiner.

Further, Examiner’s assertion that it would be obvious to combine Joseph and Teper is misplaced. One of skill in the art would not be motivated to combine the high-speed, private, trusted two-party distributed computing system of Joseph⁵ with a low bandwidth, untrusted public network such as described in Teper.⁶

⁴ A table on the server system maps the client identifier to the customer last associated with the client system. Specification at p. 9, ll. 26-29.

⁵ *See* col. 3, ll. 1-11; Abstract.

⁶ Teper allows for anonymous and secure purchases of online services over untrusted public networks, such as the Internet. *See, e.g.*, Abstract. Public networks such as the Internet connect millions of computers, and thus pose significant security concerns. *See, e.g.*, Background. Low bandwidth dial up connections were predominantly used for accessing the Internet in 1997.

Subscriber information was freely transmitted with each order using the system of Joseph because there was little risk associated with the communication. *See, e.g.,* Joseph, col. 8, ll. 56-60.⁷ However, because Teper uses a system of many users creating temporary, stateless connections to multiple service providers, security concerns are paramount. *See, e.g.,* Teper, Background. Thus, the issues that the industries respectfully represented by Joseph and Teper would face would likely have little overlap, and therefore, would not look to each other for guidance.

Finally, Joseph's security teaches away from the anonymization technology described in Teper. The ordering process described in Joseph is possible *because* the connection between subscriber and provider is secure. *See, e.g.,* Teper, col. 8, l. 34 – col. 9, l. 2; Fig. 1 and accompanying text. However, combining Joseph with Teper would introduce unsecure interactions into the secure system of Joseph due to use of the Internet, which would impermissibly change the principle of operation of the Joseph reference. MPEP 2143.01. Thus, for at least these additional reasons, Applicants submit that claims 108, 151, and 176 are patentable over the cited references, considered alone or in the combination suggested by the Examiner.

The Examiner next argues that the combination of Joseph and Teper teach the element “when an item is to be ordered, displaying information identifying the item and displaying an indication of a single action that is to be performed to order the identified item,” except for displaying an indication of the single action to be performed. *See* Examiner's Answer at p. 5. In support of this argument, the Examiner cites a section of Joseph reciting pressing a TV remote

⁷ This is because the delivery network was under the control of the server (e.g., cable TV provider), who knew the identity of the subscriber (e.g., by the transmission means 30 connected to the subscriber's home), and the subscriber always interacted with the same entity (the cable provider via the central processing facility 60). *See, e.g.,* Joseph, col. 8, l. 34- col. 9, l. 2; Fig. 1.

control button to place an order. *Id.* No reference is made to Teper with respect to this element. In addition, the Examiner alleges that “it was old and well known in the art at the time of the invention to include instructions such as a display of an indication of a button to press to impose an executable action on a web page.” Applicants disagree.

At the time of the invention, web pages on the Internet typically used hyperlinks to impose executable actions rather than displaying an indication of which buttons to press for an action. Even if one were to assume *arguendo* that this was well known, it does not follow that it was well known in the art to display an indication of a single action that is to be performed *to order the identified item*. This claimed feature provides more than a mere display indicating that an action will occur when a button is pressed, rather, it provides display of an indication that a single action is all that is required to place an order for the identified item.

Further, the Examiner tries to “take[] Official Notice *that it would have been obvious to a person having ordinary skill in the art* to include in Joseph/Teper the displayed indication of what button to press to activate the order....” Applicants traverse this Official Notice as improper. Whether the claimed elements would have been obvious to one of skill in the art is precisely what is in dispute, and thus clearly cannot be categorized as “capable of instant and unquestionable demonstration as being well-known” as required for a proper Official Notice.⁸

In addition, Applicants disagree that it would have been obvious to apply knowledge in the art of Internet web pages to the distributed computing system of Joseph in the manner suggested by the Examiner, for the reasons indicated above regarding the combination of Joseph and Teper.

⁸ According to MPEP 2144.03: “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.”

Next, the Examiner alleges that the combination of Joseph and Teper disclose “in response to a single action being performed, sending *to the server system* a request to order the identified item along with the *client identifier*.” Examiner’s Answer at p. 6 (emphasis added). Again, the Examiner is incorrect.

Joseph describes, in response to pushing a button on a TV remote, that *viewer information* is appended to an item number corresponding to the item to be ordered, and is transmitted *to a central computer*. See, e.g., Joseph, col. 8, l. 52 – col. 9, l. 2.⁹ Joseph does not send any information, much less a client identifier, to *the server system*. Compare Joseph, Fig. 1. Even if the central computer 60 of Joseph could be characterized as a server, it is not “*the server system*” from which the client identifier was received, as is required by the antecedent basis for the present claims. Moreover, it is impossible for the client of Joseph to send any information to the server 10, because the transport mechanism 30 from the server 10 to the client computers 20 is a “one way,” “unidirectional” link. See, e.g., Joseph, col. 3, ll. 7-9; col. 4, ll. 28-31.

Nor does Teper remedy this shortcoming of Joseph. As with Joseph, the entity to which user information is sent when a service is accessed in Teper is not *the same* entity from which the user information is received, as required for proper antecedent basis of the present claims. Teper describes upon accessing a service, initiation of a challenge-response-authentication protocol with the SP site 50, during which information about the service requested and user information (e.g., user ID and password) is sent to the SP site 50. See, e.g., Teper, Fig. 3 and accompanying text. Rather, the user ID of Teper is received at the user computer 40 from the online brokering site 60. See Teper, col. 2, l. 65-col. 3, l. 4. The online brokering site 60 and SP site 50 are separate, independent entities, as is necessitated by the security process of Teper. See, e.g., Teper, Summary.

⁹ The viewer information includes, e.g., name, address, method of payment and credit card number. *Id.*

Thus, the combination suggested by the Examiner does not disclose this claim element, and Applicants submit that claims 108, 151, and 176 are patentable over the cited references for at least this reason.

In addition, as discussed above, the combination of Joseph and Teper does not disclose a client identifier identifying a client system. Thus, applying this step without a client identifier would mean that client information (e.g., sensitive user information such as a credit card number) would be sent over the network. This is in direct conflict with what the presently claimed invention accomplishes: to prevent repetitive sending of a user's sensitive data over a network. Thus, claims 108, 151, and 176 are patentable over the cited references for this additional reason.

Continuing on, the combination of Joseph and Teper does not disclose "wherein the user does not need to log in to the server system when ordering the item," contrary to the Examiner's assertions that Teper shows this claimed feature. Examiner's Answer at p. 20. There the Examiner disagrees with Applicants' assertion that Teper requires that the user enter a password before a purchase can be made, and directs Applicants to col. 3, ll. 50-53 of Teper: "where the password is stored on the client side so that the password need not be *reentered*" (emphasis added).

The Examiner's citation is a mischaracterization of Teper. By pointing to a small section of the reference out of context, the Examiner has obscured its actual meaning. Teper describes the process of launching a session (col. 3, ll. 32-34), wherein a user *enters a password* (col. 3, l. 15), and the user's computer temporarily "cache[s] the user password *once it has been manually entered*, allowing the user access [sic] one SP site after another without having to *reenter* the

password.” Teper, col. 3, ll. 50-54 (emphasis added).¹⁰ Therefore, Teper *absolutely* requires that the user enter a password, i.e., at the beginning of the session, before an order can be placed. Thus, sensitive user information (i.e., the user password) is transmitted over the public network each time an order is placed. This is in contrast to the presently claimed invention, which transmits a client identifier set up to avoid sending sensitive user information.

With respect to the claimed element: “wherein the user does not need to log in to the server system when ordering the item, but needs to log into the server system when changing previously supplied account information,” the Examiner alleges that “the two acts of logging in and not logging in are separate operations; one not necessarily being dependent on the other.” Examiner’s Answer at p. 19. The Examiner then uses this argument as fuel to impermissibly launch a piecemeal attack against this claimed feature. The Examiner’s position is incorrect and fails to follow the language of the claims.

Applicants note that but a single operation—logging in—is described in this element of the claims. This claimed feature dictates *which conditions* require the log in, and which do not. When read in the context of the claim as a whole, it is apparent that these conditions are connected (not separate) and are *interdependent*.

According to the claims, the server system stores account information, changes to which require a log in. The server stores a client identifier that identifies the account information, which is sent to the client system from the server, where it is stored. When an item is ordered, the stored client identifier is sent to the server system for identification of the associated account information in lieu of a log in. Thus, it is *precisely because* the account information is secured on the server system via the log in, and that the client identifier identifies that account information, that an order may be placed *without* logging in to the server system. Because the conditions

¹⁰ See also col. 10, ll. 19-26 (“the brokering client 44 must initially obtain the user’s password”).

must be considered together to realize the benefits of the claimed invention, these aspects are dependent on each other and must be considered together. The Examiner's stance that the conditions for the log in are "separate" and "independent" conveniently ignores the claimed language and is factually inaccurate.

The Examiner's piecemeal treatment of the elements of the claimed invention ignores the overall context of the claimed invention and renders the individual limitations meaningless. By considering the conditions of the log in requirement piecemeal, the Examiner attempts to combine the system of Joseph, for which a log in to the server is *never required for any reason* (Joseph does not disclose this feature and does not even suggest why it would be available), with the system of Teper, for which a standard log at the beginning of each session is *required for all operations*. Thus, the Examiner's allegation that this combination renders obvious the presently claimed invention, which recites a (selective) log in, which is needed for some actions but not for others, is untenable. In fact, the combination of Joseph and Teper as suggested by the Examiner, if such a combination could be made, leads to exactly the opposite conclusion: that conventional systems either required a log in for *all* operations, or did not use a log in *at all*.

Moreover, these aspects are so intertwined that even the Examiner's own articulation of the limitation could not avoid making the connection between them: "the log in feature is for updating a database that holds the information *that will be used once the client ID is sent to the server* (FIG 3), the ordering of the items without a log in is separate..." Examiner's Answer at p. 13 (emphasis added). The italicized and bold language describes, in conjunction with the "log in feature," an action that occurs only *as a result of an item being ordered without* a log in, the exact action that the Examiner argues is unconnected to the "log in feature." Thus, even the Examiner was unable to describe these aspects without relating them to one another.

Hence, in view of the arguments advanced above, Applicants submit that the basis for the rejection on the grounds of 35 U.S.C. §103(a) with respect to claims 108, 151, 176 should be reversed by the Board.

Claims 109-123, 152-156, and 177-183 respectively depend from claims 108, 151, and 176, which were shown above to be patentable over the cited references. In addition, these claims recite additional limitations that also are not disclosed by the cited references. Therefore, Applicants submit that dependent claims 109-123, 152-156, and 177-183 also are patentable over the cited references.

With respect to these dependent claims, the Examiner once more appears to largely rely on Official Notice rather than addressing the claims on the merits. As previously noted, Applicants submit that this is a misuse of Official Notice, and request that the Board reverse the basis for the rejection on these grounds or at least remove these statements from the record.

With respect to claims 114-115, and 181, the Examiner takes Official Notice that “displaying partial information to protect the users personal information was old and well known in the art at the time of the invention.” Examiner’s Answer at p.7. Applicants traverse this Official Notice.

Applicants submit that it was not “well known” at the time of the invention, i.e., 1997, to display partial information, such as partial identity information, or partial shipping information as claimed. Applicants have never agreed with this taking of Official Notice and intended to traverse by way of filing the Appeal. Again, Applicants request reversal of the rejection on these grounds. Alternatively, Applicants request that the Board have the Examiner provide a reference that shows the alleged “well known” features.

Regarding claims 117, 155, and 183, the Examiner alleges that Joseph teaches the use of a shopping cart model. The Examiner provides no column and line reference within Joseph.

The Examiner next points to Applicants' disclosure as evidence of the conventionality of the shopping cart model and "that selectively including or excluding an alternative would be obvious." Examiner's Answer at p. 7. The Examiner once again has self-servingly mischaracterized this portion of Applicants' specification. The section cited by the Examiner recites:

The server system, however, only adds the single-action ordering section when single-action ordering is enabled for that purchaser at that client system. (One skilled in the art would appreciate that a single *Web page* on the server system *may contain all these sections* but the single-action ordering *section* can be selectively included or excluded before sending the Web page to the client system.)

Specification at p. 6, l. 26 – p. 7, l. 1 (emphasis added).

This section indicates that the art of web page design allows for multiple sections on a web page that can be included or removed before the page is sent to the client system. This allows for the turning on and off of single-action ordering. However, this section of the specification merely suggests that the ability to *display or not display* sections of the web page was known.

With respect to claim 119, the Examiner indicated that he acquiesced to Applicants' arguments regarding time intervals and availability in that the Examiner has relied on Applicants' own disclosure and removed the argument from consideration, as noted herein. Examiner's Answer at p. 22. Thus, the Examiner's arguments relating to these points should not be considered by the Board.

Thus, in view of the arguments advanced herein, Applicants submit that the basis of the rejection on the grounds of 35 U.S.C. §103(a) with respect to claims 109-123, 152-156, and 177-183 should be reversed by the Board.

Claims 118, 126, 156, and claims dependent on 158 (and their respective dependencies)

Claims 118-123, 126-137, and 159-163 have been rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,819,034 (“Joseph”) in view of 5,815,665 (“Teper”) in view of Official Notice and further in view of 5,893,076 (“Hafner”). Applicants traverse this rejection.

The Examiner alleges that the combination of Joseph and Teper teaches the claimed elements except that orders are combined. For the reasons asserted above, the combination of Joseph and Teper does not disclose the claimed elements, nor would it be obvious to combine Joseph with Teper. Hafner does not remedy these shortcomings of Joseph and Teper, nor does the Examiner assert that it does.

The Examiner alleges that it would be obvious to include in the combination of Joseph and Teper the consolidation capability of Hafner because “this would facilitate increased optimization by better controlling inventory and shipping costs.” Examiner’s Answer at p. 11. Thus, it appears that the Examiner is impermissibly relying on Applicants’ own disclosure of the claimed invention in order to find the motivation to reject these claims. Multiple locations in Applicants’ disclosure refer to reducing or minimizing shipping costs and controlling orders based on inventory. *See, e.g.*, Specification, p. 8, l. 20 – p. 9, l. 11; p. 12, ll. 2-12; p. 13, ll. 2-19. The Examiner’s action clearly is impermissible. As further described below, there simply is no permissible motivation provided for combining Hafner with Joseph and Teper.

Moreover, there is no reason why one skilled in the art would be motivated to combine Hafner with Joseph and Teper; the only motivation shown by the Examiner is the guidance provided by Applicants' own disclosure. As described above, Joseph describes a user-driven, private distributed computing system in which a server consistently produces a data stream over a high-speed, one-way communication path from the server to the client. *See* Joseph, col. 3, ll. 1-11. Teper allows for anonymous and secure purchaser-driven use of online services over untrusted public networks with low bandwidth. *See, e.g.,* Teper, Abstract.

In contrast to these user-driven systems, Hafner discloses a system for supplier-driven business processing and communications between retailers and suppliers who have formed a trusted business relationship and inventory history. *See, e.g.,* Hafner, col. 1, ll. 8-18. Hafner is driven by its standard item, repeat business model, in which retailers regularly order certain quantities of certain items from the supplier. As a result, Hafner allows the supplier access to the retailer's inventory and order placement without the retailer's approval. *See, e.g.,* Hafner, col. 2, ll. 29-38. It is this access that allows the supplier of Hafner to modify orders, such as by combining them.

As a result, it is unlikely that one of skill in either art would look to the other for guidance. Joseph and Teper describe user-driven ordering of individual goods and services, whereas Hafner describes a supplier-driven, repeat business, standard item system of remote retailer inventory replenishment by suppliers. Since the purchaser drives an individual order according to Joseph and Teper, the idea of combining multiple orders at the server system, without the benefit of Applicants' disclosure for guidance, would seem contrary to the principle of operation of Joseph and Teper. In addition, the combination likely would produce a ridiculous result. For example, when a purchaser falls below the amount regularly spends each month on products or

services, the provider would, automatically and without authorization, send and charge for additional items. Moreover, the combination of these three references is further improbable because, as discussed above, it is unlikely that one of skill in either art the time of the invention would be motivated to combine Joseph and Teper. As a result, it seems unlikely that one of skill in any of these three areas of art would look to either of the others for guidance.

The Examiner admits that the combination of Joseph, Teper, and Hafner is deficient with respect to “all the time intervals and availability of items of the instant claims.” The Examiner instead relies on Applicants’ own disclosure and Official Notice. Examiner’s Answer at p. 11. The Examiner cites page 12, lines 9-12 of Applicants’ specification in support of this argument. *Id.* Applicants cited this reliance on their own disclosure as improper (Appeal Brief at 25), and elsewhere in the Examiner’s Answer the Examiner acquiesced and agreed to remove this argument from consideration by the Board (Examiner’s Answer at 22). However, this argument is still present in the rejection (Examiner’s Answer at p. 11). Applicants request that Examiner’s argument be removed from consideration by the Board.

The Examiner also takes Official Notice that it was old and well known in the art at the time of the invention “to place time intervals on processing time and combining [sic] deliveries/orders based on availability,” and alleges that it would have been obvious to combine this knowledge with the combination of Joseph, Teper, and Hafner because this would “assure that the orders *are processed in a timely manner* and would also allow orders to be combined in a manner that is optimized.” Examiner’s Answer at p. 11.

Applicants traverse this Official Notice as improper. Applicants submit that the Examiner is mistaken that it was well known in the art to combine multiple requests to order items into a single order using time intervals or based on availability as described in these

various claims. Indeed, at the time of Applicants' invention, most ordering systems relied on a shopping cart and checkout method of receiving orders. As a result, Applicants request the Examiner provide one or more references that show these alleged "well known" features, indicating where and in which references the specific claimed limitations are shown.

Applicants further submit that this traversal of Official Notice is timely made. Previously Applicants' indicated that they did not understand the Official Notice, and thus could not properly traverse it. Appeal Brief at p. 12.

The Examiner's assertion that it would have been obvious to combine this alleged knowledge with the combination of Joseph, Teper, and Hafner is incorrect for two reasons. The Examiner states that one of the reasons the combination would be obvious is that this would "assure that the orders are processed in a timely manner." Examiner's Answer at p. 11. However, the Examiner has acquiesced in response to Applicants' arguments that the Examiner did in fact rely on Applicants' disclosure to reject this feature based on the above quoted language, and agreed to remove this argument from consideration by the Board. Examiner's Answer at p. 16. Nevertheless, this argument is still present in the rejection. Thus, Applicants request removal of Examiner's argument on this issue from consideration by the Board.

In addition, the Examiner states that the other reason the combination would be obvious is that it "would also allow orders to be combined in a manner that is *optimized*." Examiner's Answer at 11. Applicants requested clarification of this point as to *what* the Examiner believes would be optimized. Appeal Brief at 16. In response, the Examiner indicates that combining orders would "optimize the grouping of orders." Examiner's Answer at p. 19.

This argument is circular and impermissibly relies on Applicants' own disclosure. A common definition of "combine" is to join or group. Thus, the Examiner's argument is that

combining orders would optimize the combining (“grouping”) of orders. This does not provide an adequate rationale to support Examiner’s conclusion, without the impermissible benefit of Applicants’ own disclosure, since combining orders (e.g., into a group) is precisely what is claimed.

Thus, the Examiner has not provided acceptable motivation for coming Joseph, Teper, and Hafner as suggested. Claims 118, 126, 156 and claims dependent on 158 are patentable over the cited references for at least this reason. Therefore, in view of the arguments advanced herein, Applicants submit that the basis of the rejection on the grounds of double patenting with respect to claims 118, 126, 156, and claims dependent on 158 should be reversed.

Claims 119-123, 127-137, and 159-163 respectively depend from claims 118, 126, and 158, the subject matter of which were shown above to be patentable over the cited references. In addition, these claims recite additional limitations that also are not disclosed by the cited references. Therefore, Applicants submit that dependent claims 119-123, 127-137, and 159-163 also are patentable over the cited references.

With respect to claims 127 and 159, the Examiner indicated that he acquiesced to Applicants’ arguments regarding time intervals and availability in that the Examiner has relied on Applicants’ own disclosure and removed the argument from consideration, as noted herein. Thus, the Examiner’s arguments relating to these points should not be considered by the Board. Examiner’s Answer at p. 22.

In addition, Applicants note that the rejections applied to claims 114-115, and 181 and apply to claims 134-135 and 137, respectively, and make the same arguments here by reference.

Hence, in view of the arguments advanced above, Applicants submit that the basis for the rejection on the grounds of double patenting with respect to claims 119-123, 127-137, and 159-163 should be reversed.

The Rejections Based on Obviousness-Type Double Patenting Should Be Reversed

Claims 108-123, 126-137, 151-156, 159-163, and 176-183 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 5,960,411 ('411 Patent) in view of U.S. Patent No. 5,893,076 ("Hafner"). Applicants traverse this rejection.

Claims 108, 151, and 176 (and their respective dependencies)

Despite Applicants' prior identification of the fact that the Examiner has neglected to follow the correct procedure for obviousness-type double patenting rejections under MPEP 804,¹¹ the Examiner persists in stating that "the claims of Patent '411' teach placing single action orders over an electronic network and the other claimed features of the instant application...." Examiner's Answer, at p. 4. This neither identifies a claim in the patent, nor the claim in the application to which the claim in the patent is to be compared. Thus, the Examiner has failed to properly establish an obviousness-type double patenting rejection.

The Examiner argues that the claims of the '411 patent in combination with Hafner teaches all limitations of the claims except that "a log in is required to change account information of the user." Examiner's Answer, at p. 4. From the Examiner's oversimplification and impreciseness, it is difficult to ascertain exactly which element the Examiner seeks to

¹¹ According to MPEP 804, an obviousness-type double patenting rejection should make clear: (a) the differences between the inventions defined by the conflicting claims—a *claim* in the patent compared to a *claim* in the application; and (b) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent (emphasis provided).

address. Applicants' best guess is that the Examiner is indicting that some or all of the following claim elements are missing:

- when account information is to be changed,
 - coordinating the log in of the user to the server system;
 - receiving updated account information; and
 - sending the updated account information to the server system
- whereby the user does not need to log in to the server system when ordering an item, but does needs to log in to the server system when changing previously supplied account information.

It is clear from this that the Examiner has not made the required claim-to-claim comparison, and therefore, has failed to carry his burden of proof with respect to this issue. Thus, Applicants are forced to guess which elements the Examiner believes to be disclosed by the combination of the '411 patent and Hafner, and which the Examiner believes to be missing.

The Examiner then takes Official Notice that "it was old and well known in the art at the time of the invention to have a remote storage site containing personal information authenticate users before information could be changed," and concludes that combining this knowledge with the combination of the '411 patent and Hafner renders the claimed invention obvious. Examiner's Answer, at pp. 4-5. Applicants disagree with this reasoning and conclusion. Even if the material that the Examiner lists was in fact old and well known in the art, Applicants submit that that material does not encompass all of the above quoted claim limitations. As a result, Applicants traverse the Examiner's use of Official Notice as not properly corresponding with the specific elements of the claimed invention. Without the proper analysis to which Applicants' are entitled, the Examiner should not be permitted to rely on Official Notice. In addition, because Applicants assert that not all of the above quoted claim limitations are were "old and well known" in the art as defined by the manner Application claims arranged them at the time of the invention, the bases for this Official Notice is improper.

Applicants further submit that this traversal of Official Notice is timely made. The Examiner alleges that Applicants have not adequately traversed this taking of Official Notice. Examiner's Answer at p. 14. Applicants submit that in their Appeal Brief they challenged the Official Notice as incomplete and argued that the Examiner had not made out a *prima facie* case of unpatentability. Appeal Brief at p. 12. Because the Examiner has indicated that he believes the prior traversal to be inadequate, Applicants have provided the additional traversal arguments in the above paragraph.

The Examiner also alleges that the claim element "whereby the user does not need to log in to the server system when ordering the item, but needs to log into the server system when changing previously supplied account information" includes two "separate" operations "in that one feature is not dependent on the other." Examiner's Answer at p. 13. The Examiner is incorrect. For the reasons articulated above with respect to this issue, this element recites a single operation—logging in—and lists conditions as to when the operation is required or not. As a result, these conditions are connected and interdependent. Because the conditions must be considered together to realize the benefits of the claimed invention, these aspects are dependent on each other and must be considered together.

Here, the Examiner also impermissibly relies on Applicants' own disclosure of the invention to reject these claims. In a double patenting rejection, only the portion of the patent disclosure that supports the invention as claimed in the patent may be considered. *See* MPEP 804; *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). However, the Examiner points to the entirety of Figures 3 and to Figures 8A-8C of Applicants' disclosure to support his argument, which impermissibly uses portions of Applicants' disclosure beyond the portion that supports the claims of the '411 patent (e.g., Figures 8A-8C describe the process by

which account information is gathered, which does not support any of the claims of the ‘411 patent).

Claims 109-123, 152-156, and 177-183 respectively depend from claims 108, 151, and 176, which were shown above to be patentable over the cited references. In addition, these claims recite additional limitations that also are not disclosed by the cited references. Therefore, Applicants submit that dependent claims 109-123, 152-156, and 177-183 also are patentable over the combination of the ‘411 patent and Hafner. By this reference Applicants also apply the other arguments articulated about with respect to these dependent claims.

Hence, in view of the arguments advanced above, Applicants submit that the basis for the rejection on the grounds of double patenting with respect to claims 108-123, 152-156, and 177-183 should be reversed by the Board.

Claims 118, 126, 156, and claims dependent on 158 (and their respective dependencies)

The Examiner alleges that the ‘411 patent in combination with Hafner teaches all limitations of the claims except that “orders are combined.” Examiner’s Answer at p. 4. It appears that the Examiner is indicting that some or all of the following claim elements are missing:

wherein the server computer automatically combines orders into a single order (126)
wherein the server system combines multiple requests to order items into a single order (118)

As noted above, the Examiner has not made the required claim-to-claim comparison, thus Applicants are forced to guess which elements the Examiner believes to be disclosed by the combination of the ‘411 patent and Hafner, and which the Examiner believes to be missing.

The Examiner alleges that it would have been obvious to a person of ordinary skill in the art at the time of the invention to include in the claims of the ‘411 patent the “consolidation capability” as taught by Hafner. Examiner’s Answer at p. 4. The Examiner’s rationale for combining the two references is “because this would facilitate increased optimization by better controlling inventory and shipping costs.” *Id.*

For the reasons discussed above with respect to non-obviousness, the Examiner impermissibly relies on Applicants’ own disclosure of the invention to reject these claims. Moreover, there is no reason why one skilled in the art would be motivated to combine Hafner with Joseph and Teper; the motivation shown by the Examiner is the guidance provided by Applicants’ own disclosure, also discussed above.

With respect automation of order consolidation, the Examiner also alleges that “It is clear that the object of Hafner is to automate the consolidation of the orders as is suggested in col. 2, line [sic] 23-25) [sic].” Examiner’s Answer at p. 15. This glossed reading of Hafner is factually inaccurate.

It appears that the Examiner is referring to the following language: “It is a further object of the present invention *to provide this access automatically* and with a minimum of human intervention.” Hafner, col. 2, ll. 23-25 (emphasis added). When read in context, it is clear that “*this access*” refers to the prior sentence, which describes “access *to forecasting* based on the retailer’s inventory and sales activity,” which falls within the overall object of Hafner to provide more reliable, affordable, and efficient management of retailer’s inventory. Col. 2, ll. 17-22 (emphasis added). Applicants submit that contrary to the Examiner’s contention above, this language does not indicate or even suggest that Hafner has as an object to “automate the consolidation of orders.” In fact, Hafner makes only a cursory mention of consolidation *at all*, as

an example of order modification, discussing it for a total of five lines. Hafner, col. 8, l. 23; col. 10, ll. 23-26.

Even assuming *arguendo* that by some other rationale the above combination were suggested, the Examiner admits that the combination of the '411 patent claims and Hafner is deficient to disclose "all the time intervals and availability of items of the instant claims." The Examiner once more instead relies on Official Notice that it was old and well known in the art at the time of the invention "to place time intervals on processing time and combining [sic] deliveries/orders based on availability," and alleges that it would have been obvious to combine this knowledge with the '411 patent claims and Hafner because this would "assure that the orders are processed in a timely manner and would also allow orders to be combined in a manner that is optimized." Examiner's Answer at p. 4.

As discussed above, the Examiner again fails to make the required claim-to-claim comparison of the '411 patent claims to the claimed invention. It appears that the Examiner is referring to some or all of claims 119-123, 127-131, 159-163. The Official Notice as improper for the reasons described above with respect to section 103¹² and therefore, should be reversed.

The Examiner's assertion that it would have been obvious to combine this alleged knowledge with the '411 patent claims and Hafner is incorrect for two reasons, as articulated above: (1) the Examiner has acquiesced in response to Applicants' arguments that the Examiner did in fact rely on Applicants' disclosure to reject this feature and agreed to remove this argument from consideration by the Board (Examiner's Answer at p. 16); and (2) the Examiner's combining optimizes grouping argument is circular and relies on Applicants' own disclosure as discussed above.

¹² Applicants further submit that this traversal of Official Notice is timely made for the reasons articulated above.

Claims 119-123, 127-137, and 159-163 respectively depend from claims 118, 126, and 158, the subject matter of which were shown above to be patentable over the cited references. In addition, these claims recite additional limitations that also are not disclosed by the cited references. Therefore, Applicants submit that dependent claims 119-123, 127-137, and 159-163 also are patentable over the cited references. By this reference Applicants also apply the other arguments articulated about with respect to these dependent claims.

Thus, in view of the arguments advanced herein, Applicants submit that the basis of the rejection on the grounds of double patenting with respect to claims 119-123, 127-137, 159-163 should be reversed by the Board.

Conclusion

Applicants submit that claims 108-123, 126-137, 151-156, 159-163, and 176-183 as pending are patentable over the references cited, alone or in the combinations suggested by the Examiner. The Examiner's rejections of claims 108-123, 126-137, 151-156, 159-163, and 176-183 are erroneous, and Appellants respectfully request that the Board reverse the grounds for rejection of all appealed claims.

Respectfully submitted,
PERI HARTMAN, ET AL.

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